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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,431

10/05/2005

Reiner Hannen

23386

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535 7590 01/28/2009
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EXAMINER

ADAMS, GREGORY W

ART UNIT

PAPER NUMBER

3652

MAIL DATE

DELIVERY MODE

01/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,431	Applicant(s) HANNEN ET AL.	
	Examiner GREGORY W. ADAMS	Art Unit 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Appeal Brief

In view of the appeal brief filed on Dec. 16, 2008, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the low-friction foil of claim 24 and coating of claim 25 must be shown or the feature(s) canceled from the claim(s). Oil film is disclosed in the specification page 7, lines 26-27. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Claim 15 recites the broad recitation resilient, and claim 16 recites elastomer which is the narrower statement of the range/limitation. see

www.dictionary.com defining resilient as “springing back; rebounding” a well known quality of rubber, a type of elastomer.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Low-friction foil as added on April 12, 2008 was not in the original disclosure filed Oct. 5, 2005 or its priority documents as best understand without a foreign translation. For purposes of examination it is assumed this typo should have read --oil--.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneda et al. (US 6,073,926) (previously cited) in view of Lucas (US 6,073,926). Kaneda et al. disclose an apparatus for aligning a stack of flexible sheets on a substrate having an outer edge, some of the sheets projecting laterally past one of the edges, the apparatus comprising:

- a stabilizing element 42a,b shiftable horizontally toward (FIG. 8B) and away (FIG. 8A) from one edge of a substrate (e.g. "tray") and having a face directed toward sheets 2, 2a;
- a slip-preventing layer 43 on a face; and
- means (C5/L47-50) for shifting an element horizontally toward a stack and substrate for engaging projecting sheets and pushing same inward on a substrate to a position lying on or inward of an outer edge without vertically bending or deflecting sheets.

Under the doctrine of 35 USC 112, sixth paragraph, Lucas comprising means for shifting an element horizontally including supporting structure 7, 8, roller arrangements 17, 18 for both left-hand aligning device 24, 36 and right-hand aligning devices 24, 36. Lucas discloses "means for straightening the load itself in relation to the support pallet"

so that downstream operations on a stack such as shrinking furnace (C1/L34) are unhindered. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Kaneda et al. to include Lucas' means so that a shrinking furnace will function properly.

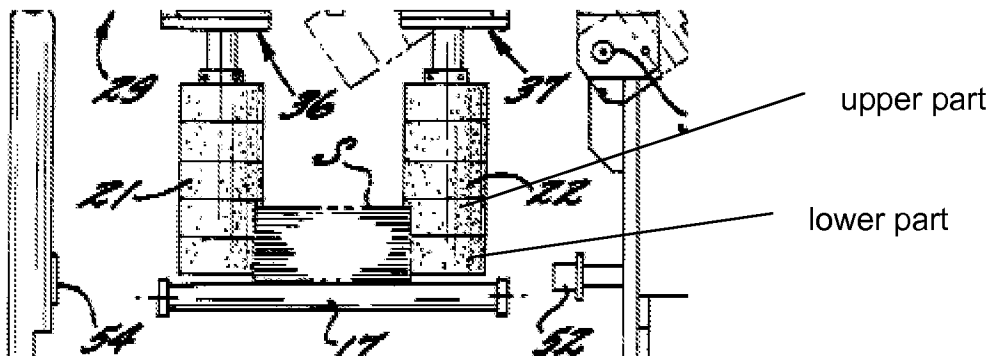
Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneda et al. in view of Lucas and further in view of Newsome et al. (US 6,231,299) (previously cited).

With respect to claims 15-16, Kaneda et al. disclose sponge material or some type of elastomer. Newsome et al. disclose stabilizing elements that shift horizontally comprising soft foam rubber layer²¹, ²², one version of elastomer (www.dictionary.com). Newsome et al. teaches that this "construction permits the outer periphery to be readily deflectable, as is seen in FIG. 4, so as to firmly engage the stacks of documents passing through the gate without damaging the stacks. Also, the resilient rolls act to laterally align the documents in the stacks as they pass through the gate. Each roll typically has a diameter of about 4 inches and a height of about 10 inches." C4/L6. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Kaneda et al. to include a layer of elastomer, as per the teachings of Newsome et al., to prevent damage to stacks.

With respect to claim 17, Newsome et al. disclose an element having an upper and lower parts (see figure below.) Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of

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Kaneda et al. to include upper and lower parts, as per the teachings of Newsome et al., to prevent damage during stack alignment.



Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneda et al. in view of Lucas and Newsome et al. and further in view of Dietz (US 233,483). Dietz discloses two parts joined at a nonplanar interface *a*, *a'* so as to form a close fitting lock-joint. P1/L20-26. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Kaneda to include joining two parts in a nonplanar interface, as per the teachings of Dietz, to lock two adjacent parts.

Claims 19-20 & 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneda et al. in view of Lucas and Greller (US 4,400,124). Kaneda et al. disclose an apparatus for aligning a stack of flexible sheets on a substrate having an outer edge, some of the sheets projecting laterally past one of the edges, the apparatus comprising:

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- a stabilizing element 42a,b shiftable horizontally toward (FIG. 8B) and away (FIG. 8A) from one edge of a substrate (e.g. “tray”) and having a face directed toward sheets 2, 2a;
- a member on an element; and
- means (C5/L47-50) for shifting an element horizontally toward a stack.

Under the doctrine of 35 USC 112, sixth paragraph, Lucas comprising means for shifting an element horizontally including supporting structure 7, 8, roller arrangements 17, 18 for both left-hand aligning device 24, 36 and right-hand aligning devices 24, 36. Lucas discloses “means for straightening the load itself in relation to the support pallet” so that downstream operations on a stack such as shrinking furnace (C1/L34) are unhindered. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Kaneda et al. to include Lucas’ means so that a shrinking furnace will function properly.

Greller et al. discloses-

- a member 41 on an element 27 engageable under a stack;
- means (C4/L6-25) for shifting an element 27 horizontally toward a stack and fitting a member under a projecting sheets (C3/L56-59) to support same while and pushing projecting sheets inward on a substrate to a position lying on or inward of an outer edge without vertically bending or deflecting the sheets; and
- wherein an element 41 has a horizontal surface portion generally level with an upper surface of a substrate 1.

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It is noted that while Greller et al. does not explicitly disclose aligning a bottom sheet adjacent a substrate 1 a skilled artisan would understand that Greller's apparatus would align any article in said stack whether the bottom most or top most because Greller's clamp 27, 41 extends above and below a stack. Horizontal portion 41 is level with substrate 1 and subsequently applies a force against a stack in combination with clamp 27 and any projecting sheets, including a bottom most magazine, would be pushed in during clamping. Greller teaches manipulating stacks without interference by a carrying plate without smearing of printing on articles within a stack. C1. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Kaneda et al. to include Greller's means for shifting an element towards and away and horizontal surface portion to manipulate stacks without smearing.

Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneda et al. in view of Pizzi (US 6,386,824) (previously cited) and and further in view of Newsome et al.

With respect to claim 21, Kaneda et al. disclose a method of aligning a stack of flexible sheets on a substrate having an outer edge, some of the sheets projecting laterally past one of the edges, the method comprising the step of:

- pressing a nonslip surface 43 of a stabilizing element 42 against laterally projecting sheets 2a so as to push laterally projecting sheets in at least to an outer edge; and thereafter

- pressing a stabilizing element against other sheets in a stack to align them on a substrate.

Kaneda et al. disclose sponge material or some type of elastomer and does not disclose a nonslip surface. Newsome et al. disclose stabilizing elements that shift horizontally comprising nonslip soft foam rubber layer^{21, 22}. Newsome et al. teaches that this “construction permits the outer periphery to be readily deflectable, as is seen in FIG. 4, so as to firmly engage the stacks of documents passing through the gate without damaging the stacks. Also, the resilient rolls act to laterally align the documents in the stacks as they pass through the gate. Each roll typically has a diameter of about 4 inches and a height of about 10 inches.” C4/L6. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Kaneda et al. to include a layer of elastomer, as per the teachings of Newsome et al., to prevent damage to stacks.

Pizzi discloses means (C5/L61-67) for shifting an element horizontally toward a stack while pushing projecting sheets (top and bottom) inward on a substrate 2 to a position lying on or inward of an outer edge without bending or deflecting sheets and then pressing a stabilizing element 46 against other sheets in a stack to align them on a substrate. Pizzi teaches that aligning using side stabilizer elements keeps all edge faces of each stack layer from damage, i.e. set back from a pallet edge. C1. Moreover, a skilled artisan would understand that Kaneda's apparatus extends above and below a stack allowing any projecting sheet in a stack to be shifted relative to each other and a substrate. Therefore, it would have been obvious to one having ordinary skill in the art

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at the time the invention was made to modify the method of Kaneda et al. to include pushing projecting sheets in alignment and then a stabilizing element in alignment with a substrate, as per the teachings of Pizzi, to keep stack edges safely within the outer perimeter of a substrate, e.g. pallet, perimeter, for purposes of damage prevention.

With respect to claim 22, Kaneda et al. disclose a step of aligning a substrate relative to a stabilizing element (FIG. 8A) before pressing a stabilizing element against laterally projecting sheets.

Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneda et al. in view of Pizzi and Newsome and further in view of Schmitt (US 3,902,214). Schmitt discloses reducing friction using a coating of oil lubricant. Schmitt teaches application of a lubricant such as a film of oil to quiet movement of articles. C2/L10-20. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Kaneda et al. to include reducing friction by applying a coating of oil lubricant.

Response to Arguments

Applicant's arguments with respect to claims 14-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY W. ADAMS whose telephone number is (571)272-8101. The examiner can normally be reached on M-Th, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saul Rodriguez can be reached on (571) 272-7097. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory W Adams/
Primary Examiner, Art Unit 3652